

## **REMARKS**

### **Overview**

The claims now in the case are claims 25, 28-33, 37, 40-44, 48-55. Claim 1 and each other independent claim now provides for only three layers, with each of the three layers having specifically limited parameters. With respect to amended claim 1, a closed cell compressible material, an outer protective layer; and an inner layer of wool yarn or blended yarn of defined properties. As explained below and illustrated in the sample pictures authenticated by the Rule 132 Declaration, these limits are significant, patentably distinct, and different from the '158 cited prior art reference.

### **Objections Under 35 U.S.C. § 112**

The 35 U.S.C. § 112 objection has been obviated by amendment to remove the redundant use of "outer layer". It is now clear what layers are referenced in each case with proper antecedent basis.

### **Rejections Under 35 U.S.C. § 103**

The independent claims 25, 41, 48-49 and 51-55 have been amended to now clearly specify that the suit is formed of only three layers of material, an outer protective layer, a neoprene or foam layer and an inner insulation layer formed of a wool or wool blend. This clearly differentiates the suit of the invention from the cited prior '158 art as, in the '158 patent, there is no disclosure of the preparation of a suit which can be formed of only three layers of material. Indeed, it is clear that throughout the cited '158 patent, a significantly greater number of layers of material are required in order to provide the insulation effect. For example, it is

stated that with regard to the central core alone, there could be provided forty layers of material and that the invention is only achievable with as few as five layers in the central core. This teaches away from Applicants' claim limit of three layers. Thus, it is clear that even with the minimum number of layers of material the prior art '158 patent does not envisage or teach that a suitably insulated wet or dry suit can be formed with any less than five layers of material forming the central core. Thus, when one considers that the '158 patent also discloses the provision of an outer and inner layer in addition to the central core, it is clear that the disclosure of the prior art patent can only be interpreted as being that the wet suit must include, at the very least, the provision of seven layers of material to form the wall of the same.

In the current invention of the amended claims, the insulated suit is achieved by using only three layers including an outer protective layer and the foam or neoprene layer. This is achieved by the non-obvious manner in which the inner insulation layer is formed. Furthermore, we again emphasize to the Examiner that while the cited '158 prior art does disclose the provision of insulation, this insulation is achieved through the provision of the central core which comprises five or more layers of different materials. The insulation achieved in the prior art patent is not achieved by the provision of the inner layer 26 to which the Examiner refers. There is no disclosure or suggestion in the prior art that the central core could be discarded and that the required insulation effect would still be achieved, rather, in the prior art, it is the central core which is clearly essential and it is the inner layer 26 which is optional and the inner layer 26 is provided for comfort. For the Examiner's assertions to be correct, and hence relevant to the applicant's current application, the prior art document would have to disclose that in one embodiment of the prior art, the central core insulation system, could be removed and a similar insulation effect still be achieved using only inner layer 26. There is certainly no suggestion of

this in the prior art patent. The Examiner in his arguments appears to confuse and mix reference to the inner layer 26 with reference to the central core system. This is impermissible as, the central core of the suit of the prior art, in addition to the number of layers is also, in order to provide the insulation, required to be sealed from contact with water and in order to provide the insulation, it is required to be inflated. In contrast the insulation wool blend layer of the current invention is required to be exposed to and absorb liquid in order to create the insulation effect. And claim 25 is specifically so limited.

The provision of a large number of layers in the '158 patent, means that the thickness of the suit can be significant when in use; for example it is described in '158 that in use, the thickness of the walls of the suit can be an inch! In the current invention the thickness of the wall of the overall suit is typically 2-7mm. This can only be as a result of the number of layers which are used and it should be appreciated by the Examiner that provision of a suit of an inch thickness when worn, will be bulky and difficult to manipulate, and not appealing to divers.

In contrast, as the applicant has realised that insulation can be provided by a wool blend inner layer which traps water therein, the thickness of the suit achieved in the current invention is significantly less. For the sake of illustration for the Examiner, we enclose a Rule 132 Declaration authenticating pictures of a suit wall formed in accordance with the current invention. It can be seen that the outer layer and foam layer are provided of a conventional thickness and this thickness can be varied according to specific usage of the suit. However, what is most and clearly notable is that the inner wool blend layer (the blue layer), is of a single layer construction and relatively thin compared to the insulation central core of the '158 patent.

The Examiner can therefore appreciate, having viewed pictures of the sample, the clear differences between the current invention and the prior art and that the reduction in the number

of layer of material required in order to achieve an insulated suit in accordance with the invention is a patentably significant difference ,both in terms of achieving the required insulation and subsequent use of the suit.

The claims have also been amended to indicate that the wool blend insulation layer is “set” when formed by the application of heat in order to achieve the required insulation effect while ensuring that the layer can still be used as part of the suit. In use, wool, when knitted, can be stretched to an extent but, once stretched beyond a certain point, is liable to rip. When used as part of a suit for use as a wet suit or dry suit, the movement of the wearer of the suit can place the wool blend layer under tension which could cause the same to rip and thereby be unusable. The applicant has identified this problem and addressed the same by ensuring that the synthetic material which is provided as part of the wool blend is set during the manufacture of the wool blend layer. The use of heat set material is also missing from the art of record. The setting of the material ensures that the wool blend layer is capable of stretching to a point which is less than the tear point of the wool in the blend. Typically, therefore once the wool blend has been knitted, heat is applied to the wool blend layer to set the synthetic material of the wool blend layer prior to the same being applied to the neoprene.

This feature not addressed, considered or envisaged to be necessary in the prior art '158 patent cannot be seen to be obvious for the diving suit. In the prior art document, with reference to the inner layer 26, it would appear that wool, nylon or other materials are simply interchangeable and are a matter of choice. No thought is given to the fact that wool would have an advantage over nylon or vice versa or with regard to any of the other materials which are mentioned. All that is envisaged in the prior art document is that some form of material could be used to form the inner layer.

The Examiner cannot meet his burden of a *prima facie* case by unwarrantedly assuming "inherency of limits of the claims in contrast to the express teaching of the '158 prior art reference. Moreover arguing mere dimensions don't make patentably distinct limits flies in the face of evidence of record, both in the specification and in the earlier filed Gordon Rule 132 Declarations demonstrating the critical important nature of the limits of existing claim 25.

By way of example only, the Examiner is directed to the earlier filed John Gordon Rule 132 re: 50 – 500 grams per square meter claim limit; and to the world wide acceptance of this suit and the allowance of this case in the rest of the world.

Applicants have made a sincere effort to both limit the case, and to distinguish the '158 prior art in an earnest effort to favorably end this prosecution. Respectfully, an allowance is solicited.

## **Conclusion**

This is a request under the provision of 37 CFR § 1.136(a) to extend the period for filing a response in the above-identified application for three months from June 4, 2010 to September 4, 2010. Applicant is a small entity; therefore, please charge Deposit Account No. 26-0084 in the amount of \$555.00 to cover the cost of the three-month extension. Any deficiency or overpayment should be charged or credited to Deposit Account 26-0084.

No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



EDMUND J. SEASE, Reg. No. 24,741  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
**CUSTOMER NO: 22885**

Attorneys of Record

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Enclosure: 132 Declaration of Edmund J. Sease